

In re Application of: Oren GLOBERMAN
Serial No.: 10/517,938
Filed: August 9, 2005
Office Action Mailing Date: August 18, 2009

Examiner: Kevin Thao TRUONG
Group Art Unit: 3734
Attorney Docket: 38309
Confirmation No.: 3765

REMARKS

Reconsideration of the above-identified Application in view of the foregoing amendments and the following remarks is respectfully requested.

Claim Status

Claims 1-38 and 74-76 are presently pending in this Application. Claims 39-73 have been canceled. Claims 2-9, 14-17, 20, 23-38 have been withdrawn from consideration as non-elected. Claim 74, dependent on claim 10, and claims 75-76, both dependent on claim 1, and directly readable on elected species 18 have been added to provide applicant with additional protection to which he appears to be entitled.

Claims 1, 10-13, 18, 19, 21, 22 and 74-76 are accordingly presented for further examination.

Claim 1 has been amended to address an issue raised by the Examiner during a telephone interview held on December 10, 2009, as discussed below. Claims 13 and 29 have been amended to correct minor typographical errors noted during preparation of this response. No new matter has been introduced by these amendments.

Regarding Applicant's Response to the Requirement for Restriction

The Examiner's attention is respectfully directed to the fact that the response to the previous Office Action did in fact contain a partial traverse in which errors in the restriction requirement were distinctly and specifically pointed out.

For example, it was specifically stated that the elected species 18 (illustrated in Figs. 11A-12B) is an embodiment in which a balloon is folded or formed so as to define a channel for a guide-wire. It was also specifically stated that "[T]his is generally true also of Figs 8A-8D (species 14-16) and also for Fig. 5A (species 12)".

Further, 1, 10, 11, 18 and 19 were identified as generic, and claims 12, 13, 14, 21 and 22. were identified as species claims that read directly on the species 18, and that "[a]dditional claims which also relate to having a guide-wire channel defined by a

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balloon are claims 15 and 16, which read on Fig. 5A (species 12) and claim 20 (reads on Fig. 8B)".

It is respectfully submitted that the foregoing clearly points out distinctly and specifically the errors in the restriction requirement, and that the response should not be treated as without traverse. The Examiner is respectfully requested to reconsider applicant's response in light of the foregoing, (and also in light of the fact that the generic claims are allowable for the reasons stated below).

Regarding the Telephone Interview Held on December 10, 2009

Applicant acknowledges and thanks the Examiner for the courtesy extended to his representative during the telephonic interview conducted on December 10, 2009. Applicant respectfully notes, however, that no Interview Summary has been received in connection with the interview. Nevertheless, it is recalled that the Examiner raised an objection to use of the word "side" in claim 1. To address this, the word "side" has been changed to read --end--.

It is further recalled that the Examiner agreed to hold a further interview in this matter. In view of the various amendments and arguments presented herein, it is believed that the Application is in condition for allowance. However, if the Examiner considers that there are unresolved issues, it is believed that a further interview is likely to advance the prosecution. Applicant's representative will contact the Examiner shortly to ascertain if the application is now allowable, and make arrangements for an interview if necessary.

35 U.S.C. §102 Rejection:

Claims 1, 10-13, 18, 19, 21 and 22 stand rejected under 35 U.S.C. §102(b) as anticipated by Osborne et al. U.S. Patent No. 5,690,642 (Osborne). Applicant respectfully traverses and requests reconsideration of this rejection.

Independent claim 1, from which all the other rejected claims depend, recites the following:

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an elongate body adapted for insertion into a blood vessel
a tool section attached to a distal end of said body; and
a guide-channel adapted to carry at least a guide-wire,
wherein said catheter includes an entry port in said guide-
channel for said guide wire and wherein said tool includes a distal
exit for said guide wire from said guide-channel, defined in an end
of said tool.

In contrast, Osborne discloses two different arrangements, in both of which, there is provided a catheter, an inflatable balloon, and a wire-guide shaft, wherein the wire-guide shaft is coupled to the catheter tip, said coupling being completely distal of the distal end of the inflatable balloon (see, for example, .Col.2, lines 29-31, lines 43-45). In other words, Osborne's guide-wire shaft is completely external to the catheter itself

There is no disclosure, teaching, or suggestion of the catheter itself having an entry port in the guide-channel or a tool which includes *a distal exit for the guide-wire guide-channel, defined in an end of said tool*.

For the foregoing reasons, it is respectfully submitted that claim 1 is not anticipated by Osborne.

Claims 10-13, 18, 19, 21, and 22 are dependent on claim 1, as noted above, and are therefore patentable over Osborne for the same reasons as claim 1. In addition, these claims recite features which, in combination with the features recited in claim 1 are not anticipated by anything disclosed, taught or suggested in Osborne.

The Examiner's attention is further directed to claim 12 which explicitly recites that the "...guide-channel is defined between folds of said balloon.". This is clearly not the case in Osborne for the reasons stated above.

To further emphasize this distinction, new claim 74, dependent on claim 10, has been added which is like claim 12, but which recites that the guide-channel is defined by folds of said balloon. In addition, new claims 75 and 76, both directly dependent on claim 1, have been added. Claim 75 recites that the "...guide-channel is defined by the tool with no separate passage". Claim 76 recites that the "...guide channel is defined by a passage within the confines of said tool".

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These claims are also patentable over Osborne for the reasons stated above.

In view of the above remarks, it is respectfully submitted that claims 1, 10-13, 18, 19, 21, 22 and 74-76 are in condition for allowance. Further, because allowable claims 1, 10, 11, 18 and 19 are generic, the withdrawn non-elected claims should also be allowed.

A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,

/Jason H. Rosenblum/

Jason H. Rosenblum
Registration No. 56,437
Telephone: 718.246.8482

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Enclosures:

- Petition for Extension of Time (Three Months); and
- Additional Claim Fee Transmittal